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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,802	11/02/2001	Michael D. Uhler	UM-06669	3812

7590

12/28/2004

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EXAMINER

NGUYEN, QUANG

ART UNIT

PAPER NUMBER

1636

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/002,802	Applicant(s) UHLER, MICHAEL D.	
	Examiner Quang Nguyen, Ph.D.	Art Unit 1636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-25,27-32 and 34-42 is/are pending in the application.
4a) Of the above claim(s) 14-24 and 34-36 is/are withdrawn from consideration.
5) ☒ Claim(s) 38-42 is/are allowed.
6) ☒ Claim(s) 11 is/are rejected.
7) ☒ Claim(s) 1,3,4,6-10,12,13,25,27-32 and 37 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 02 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's amendment filed on 10/01/04 has been entered.

Claims 1, 3-4, 6-25, 27-32 and 34-42 are pending in the present application.

This application contains claims 14-24 and 34-36 drawn to an invention nonelected with traverse in the Amendment filed on 6/26/03. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Accordingly, amended claims 1, 3-4, 6-13, 25, 27-32 and 37-42 are examined on the merits herein.

Terminal Disclaimer

The terminal disclaimer filed on 9/28/04 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on Application No. 10/123,435 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Amendment

The rejection under 35 U.S.C. 102(e) as being anticipated by Sabatini (U.S. 6,544,790) is withdrawn in light of Applicant's amendment.

The rejection under 35 U.S.C. 103(a) as being unpatentable over Sabatini (U.S. 6,544,790; IDS) in view of Hawley-Nelson et al. (US 5,736,392) is withdrawn in light of Applicant's amendment.

The rejection under 35 U.S.C. 103(a) as being unpatentable over Sabatini (U.S. 6,544,790; IDS) in view of Hawley-Nelson et al. (US 5,736,392), and further in view of Wagner et al. (Proc. Natl. Acad Sci USA 89:7934-7938, 1992, IDS) is withdrawn in light of Applicant's amendment.

The provisionally obviousness-type double patenting rejection under the judicially created doctrine of as being unpatentable over claims of copending Application No. 10/123,435 is withdrawn in light of Applicant's submission of the terminal disclaimer filed on 9/28/04.

Claim Objections

Claims 1, 11-13, 25 and 37 are objected to because they lack the article - - a - - in front of the term "nucleic acid". Appropriate correction is required.

Claim 29 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 27. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

Amended claim 11 stands rejected under 35 U.S.C. 112, first paragraph, for the same reasons already set forth in the previous Office Action mailed on 7/2/04 (pages 2-4).

Response to Arguments

Applicant's argument related to the above rejection in the Amendment filed on 10/01/04 (page 10) has been fully considered, but it is respectfully not found persuasive. This is because Applicant simply asserts the claim is enabled as written. Examiner notes that claim 11 is not amended to the enabled scope given in the previous Office Action mailed on 7/2/04 (pages 2-4) upon the Wands factors analysis.

Accordingly, claim 11 stands rejected under 35 U.S.C. 112, first paragraph.

Conclusion

Claims 38-42 are allowed.

Claims 1, 12-13, 25, 37 and their dependent claims are objected.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang Nguyen, Ph.D., whose telephone number is (571) 272-0776.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's mentor, David Guzo, Ph.D., may be reached at (571) 272-0767, or SPE, Irem Yucel, Ph.D., at (571) 272-0781.

To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1636; Central Fax No. (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

Quang Nguyen, Ph.D.


DAVID GUZO
PRIMARY EXAMINER